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OFFICE OF PETITIONS

In re Application of	:	
John I. M. Choate	:	
Application No. 10/780,476	:	DECISION ON PETITION
Filing Date: February 16, 2004	:	UNDER 37 C.F.R. § 1.181
Title: APPARATUS THAT IMPROVES	:	
DISCOVERY OF CANCER MASS, AND	:	
REDUCES INFLAMMATION - ONSET OF	:	
SYMPTOMS OF CARPAL TUNNEL	:	
SYNDROME OR ARTHRITIS - TACTILE	:	
DEFICIT OF FINGERS, AND	:	
INCREASES DISCOVERY OF FOREIGN	:	
MASS IN BREAST AND OTHER SELF	:	
EXAMINATIONS	:	

This is a decision on the petition filed on October 1, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

Background

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed October 13, 2006, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on January 14, 2007. A notice of abandonment was mailed on September 12, 2007.

Procedural History

A petition pursuant to 37 C.F.R. § 1.183 was filed on April 16, 2007, which was dismissed via the mailing of a decision on August 6, 2007 for failure to include the required petition fee.

Relevant Portions of The C.F.R.

37 C.F.R. § 1.8 sets forth, in pertinent part:

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

- (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
 - (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
 - (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and
- (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

...

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

37 C.F.R. §§ 1.10(a) and (c) set forth, in toto:

(a)

(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

...

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

ANALYSIS

The showing in the present petition is not sufficient to withdraw the holding of abandonment.

A non-final Office action was mailed on October 13, 2006, which set a shortened statutory period for reply of three months. As such, the maximum extendable period for reply expired at midnight on April 13, 2007.

The electronic record has been reviewed, and it is noted that on April 16, 2007, an amendment, a three-month extension of time a request for the Office to waive the extension of time requirement, and the aforementioned Petition pursuant to Rule § 1.183 were received in the Office.

Each of these papers has been reviewed, and it does not appear that a certificate of mailing was placed on any of them.

With the present petition, Petitioner has asserted that these papers were mailed to the Office on April 12, 2007, and

As I mailed it from Arlington, Virginia, I had a reasonable basis to expect the response to be delivered the next day...

It appears that Petitioner believes that the present application is not in fact abandoned, as he failed to submit a reply until the terminal portion of the maximum extendable period for providing a response, and he expected that the mailing would be delivered to the Office in one day, when in fact, it took four days for the submission to reach the Office.

Rule § 1.8(a) makes it clear that the actual date of receipt in the Office is used when determining whether a piece of correspondence was timely filed. There are two exceptions to this rule: certificate of mailing/facsimile transmission practice and Express Mail practice.

Certificate of mailing practice provides a mechanism by which Applicants may evince that a paper was timely submitted to the Office, in the event that the correspondence is not received. Petitioner's submission of April 16, 2007 has been reviewed, and it does not appear to contain a certificate of mailing. As such, it does not appear that Petitioner can comply with 37 C.F.R. §1.8(b)(2).

37 C.F.R. § 1.10(c) provides an alternate mechanism by which an applicant may establish that a communication was submitted to the Office, but was not accorded the proper filing date by the same. Petitioner's submission of April 16, 2007 has been reviewed, and it does not appear that the originally deposited papers display the number of the express mail label thereon. As such, it does not appear that Petitioner can comply with either 37 C.F.R. §§ 1.10(a)(1) or (c)(2). Moreover, Petitioner has submitted a copy of a USPS Certified Mail Receipt, which suggests that this correspondence was not sent to the Office via the Express Mail service of the USPS.

Pursuant to the above discussion, the petition under 37 C.F.R. § 1.181 must be DISMISSED.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181". This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹, hand-delivery², or facsimile³. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁴.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b). Petitioner may download information about these petitions here:
http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁵. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.

4 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

5 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.